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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,071	01/13/2006	Heinz Focke	Q86252	5834
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EXAMINER				
NGUYEN, PHU HOANG				
ART UNIT		PAPER NUMBER		
1791				
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11/26/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/525,071

**Applicant(s)**

FOCKE ET AL.

**Examiner**

PHU H. NGUYEN

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/88)  
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :2/18/2005,3/3/2006,11/08/2006,5/7/2008.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1-3, 6, 11-13 contains the phrase "in particular" or "preferably" resulting a broad limitation together with a narrow limitation that falls within the limitation in the same claim. For example, claim 1 contains a broad limitation of "a perforation element" together with a narrower

limitation of "a laser perforation element". Claim 1 also contains a broad limitation of "flowing medium" together with a narrower limitation of "test air". Claim 1 further contains a broad limitation of "outer filter cover" together with a narrow limitation of "cork paper".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nowers et al. (U.S Patent No. 4569359).

Regarding claims 1-2, Nowers discloses a device for producing filter cigarettes in which an outer filter cover has openings (perforations) which are introduced into the filter cover by a laser perforation element (column 1, lines 34-38), the porosity being checked by measuring the pressure drop through the tipping paper (air test corresponding to the claimed "introducing a flowing medium – test air – at one end of the filter and measuring the air – exit air- emerging via the openings) or optical by measuring device (5, fig. 1). Nova further discloses:

a) the perforation element is arranged in the region of the device for producing the filter cigarette so it can perforate the filter of the cigarette (see figs. 1 and 2),

b) the perforation element can be adjusted with regard to the number and/or size of the openings to made in the filter cover (pages column, lines 34-38 and lines 55-63).

Nowers also discloses that the measurement of the openings is supplied to the control device in a feed back loop so that the perforation element can be adjusted accordingly to the response to changes in the results (column 11, lines 53-63).

Although Nowers does not disclose the control device is a computer, it would have been obvious to one of ordinary skill in the art that the control circuit (8, fig. 1) can be a computer since it is well known in the art that a computer can be used as a control device/system.

Regarding claim 3, Nowers discloses a control loop (see fig. 1) for adjusting the laser perforation element (4, fig. 1) depending on the result of measuring the pressure drop through the tipping paper by measuring device (5, fig. 1) .

Claims 4-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nowers et al. (U.S Patent No. 4569359) in view of Wahle et al. (U.S Patent No. 4193409).

Regarding claim 4, Nowers does not expressly disclose the filter consisting of cork paper. However it is well known in the art for withdrawing a continuous web of cigarette paper, imitation cork or other flexible material from a reel and providing holes (by laser beam) in selected portions of the web as evidenced by Wahle (column 3, lines 25-44). Accordingly, claim 4 is rejected.

Regarding claim 5, Wahle discloses the perforation element (125, fig. 5) for making openings on finished filter cigarettes is arranged above an intermediate drum (124, fig. 5) (also, column 12, lines 57-66). Also, as mentioned above for claims 1 and 4 the perforation element can be a laser perforation element.

Regarding claim 6, Wahle discloses testing unit includes a chamber where the filter cigarette is being supplied with test air and a pressure transducer (71, fig. 4) measure the pressure and then the signal is transmitted by integrated circuit (72, fig. 4) to be compared with a reference (see fig. 4 and column 11, lines 15-44).

Regarding claims 7-9 and 11, Wahle discloses as the filter cigarette is capped off by sealing elements (62a, 62b on fig. 4) which are respectively adjacent to and bear against the left hand and right hand end faces of the conveyor and respectively include arcuate grooves (61a, 61b on fig. 4) (corresponding to the claimed "hollows and matching hollows" of the instant claim 9) connected with conduits (64a, 64b on fig. 4); the conduits communicate with a source of compressed air or another suitable gaseous testing fluid by way of a conduit (67a on fig. 4) (column 10, lines 10-23).

Regarding claim 13, in addition to the features discussed above, Wahle discloses air lines (64a, 64b on fig. 4) lead to sensor (pressure transducer 71, fig. 4) and the sensor is connected to in the control loop to compare the output with a reference.

Regarding claims 10 and 12, although Wahle does not disclose resilient material; it is well known to use resilient material (such as rubber) for sealing application. Also, it would have been obvious to one of ordinary skill in the art to use resilient material for sealing the chamber of the testing unit during testing for the perforation of cigarette because the test involves measuring the pressure drop through the tipping paper and an unsealed chamber could result in false readings.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHU H. NGUYEN whose telephone number is (571)272-5931. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

P.N 11/20/2008

/Philip C Tucker/

Supervisory Patent Examiner, Art Unit 1791